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**REMARKS**

Applicants have carefully reviewed the Office Action dated September 21, 2004. Applicants have amended Claims 1, 3, 6, and 8 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

The Examiner had noted in Paragraph 2 of the *Office Action* that the *Patent* being disclaimed has been improperly identified, the Examiner noting that the number used to identify the disclaimed patent was "6,622,165," and that the correct number should be "6,615,268." However, in the *Response* that was filed on May 24, 2004, a *Terminal Disclaimer* was filed disclaiming U.S. Patent No. 6,615,268. There was a *Supplemental Amendment* that was filed at a later time, but this was not directed toward that. A copy of this document and the transmittal cover sheet is attached hereto in addition to the Auto-Reply from the PTO. Therefore, Applicant believes that no *Terminal Disclaimer* is required and that the rejection under the judicially created doctrine of obviousness-type double patenting has been previously overcome in view of U.S. Patent No. 6,615,268.

Claims 1, 4-5, 6 and 9-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Bendinelli et al.*, *Ullman et al.* and *Wolzien*. The claims as amended, are believed to overcome this rejection, and therefore, this rejection is respectfully traversed.

Applicant has previously described these three references. However, to provide more detail, the *Bendinelli* reference is a reference that is directed toward broadcasting a television signal that is comprised of a picture, a closed caption and a URL. The patent sets forth that the URLs are embedded in a closed caption portion of the transmitted television signal (Column 1, Lines 48-52). Closed captions are a text version of the spoken part of a television, movie or computer presentation. Closed captioning information is encoded within the video signal, in Line 21 of the vertical blanking interval (VBI). Therefore, a special decoder is required that must be built into a television set or available as a separate set top box in order to extract this information. As such, this information is control information that is transmitted outside of the broadcast signal and cannot be considered to be embedded within the program.

AMENDMENT AND RESPONSE  
S/N 09/378,217  
Atty. Dkt. No. PHL Y-24,707

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itself. This information also cannot be considered to be disposed within the video/audio bandwidth of the transmission since this information is typically digital in nature. Thus, the transmission is in the VBI. Additionally, the *Bendinelli* reference transmits the URL. As such, the embedded URL cannot be considered to be a unique code that does not contain routing information.

The *Ullman* reference is a reference that provides interactive programming through a television set or other display monitor in conjunction with the display of the personal computer. In one embodiment as set forth in Column 9, beginning at Line 4, a cable set top box is operable to receive a television program along with reception by a personal computer. The video program received by the personal computer is then operated on to "extract the URLs embedded in the vertical blanking interval of the video signal" (Column 9, Lines 13-16). Thus, *Ullman* is substantially identical to *Bendinelli* in that the code that is embedded has routing information in that it is a URL and also it is not within the audio/video bandwidth of the broadcast since it is disposed within the VBI.

The *Wolzien* reference is a reference that provides for embedding an address in a broadcast program that is embedded within the vertical blanking interval of a conventional video signal (Column 5, Lines 50-53). The address that is received is a URL. This address is defined as being operable to establish a direct digital communication link to an online information provider (Column 6, Lines 27-33). As such, *Wolzien* also encodes the address or URL within a VBI of the broadcast signal.

It can be seen that all three of the references are cumulative in effect in that they all utilize the VBI for transmission of the routing information and the routing information being basically a URL. As such, the information cannot be within the audio/video bandwidth of the recorded information and, further, the unique code cannot be one that has no routing information contained therein. As such, neither of these references, taken singularly or in combination, anticipate or obviate Applicant's present inventive concept, defined by the amended claims. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection with respect to Claims 1, 4-5, 6 and 9-10.

AMENDMENT AND RESPONSE  
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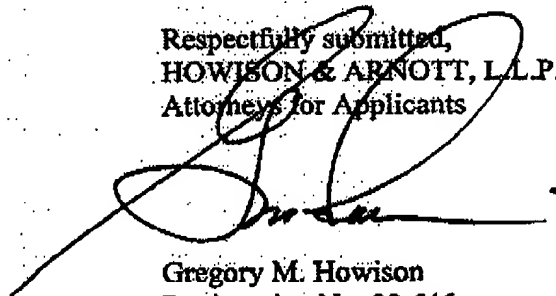
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Claims 2-3 and 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Bendinelli*, *Ullman* and *Wolzien* and further in view of *Hitzelberger*. Applicant respectfully traverses this rejection.

The addition of *Hitzelberger* does not cure the deficiencies noted herein above with respect to the combination of *Bendinelli*, *Ullman* and *Wolzien*. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection with respect to Claims 2-3 and 7-8.

Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-24,707 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,  
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January 21, 2005

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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/378,217
	Filing Date	August 19, 1999
	First Named Inventor	Philyaw
	Art Unit	2142
	Examiner Name	Chau T. Nguyen
Total Number of Pages in This Submission	Attorney Docket Number	PHLY-24,707

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavit/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Credit Card Form
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Date	5/24/04	

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Typed or printed name	Gregory M. Howison	
Signature		Date 5/24/04

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# **TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

In re Application of: PHilyaw

Application No.: 09/378,217

Filed: August 19, 1999

For: A Method for Controlling a Computer Using an Embedded Unique Code in the Content of CD Media

The owner\*, L.V. PARTNERS, L.P., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,615,268. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

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Signature

Date

Gregory M. Howison, 30,646

Typed or printed name

972-680-8050

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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